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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,878	11/26/2003	Bernardus Antonius Maria Oude Alink	194-25697-USCP	9329

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EXAMINER
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ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b> 10/723,878	<b>Applicant(s)</b> ANTONIUS MARIA OUDE ET AL.	
	<b>Examiner</b> Joseph D. Anthony	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
     4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5, drawn to a corrosion inhibited fluid, classified in class 252, subclass 390.

II. Claims 6-12, drawn to a method of inhibiting corrosion, classified in class 507, subclass 240.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a process of washing textiles on a wooden washboard.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with David L. Mossman on 06/09/06 a provisional election was made with traverse to prosecute the invention of Group II,

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claims 6-12. Affirmation of this election must be made by applicant in replying to this office action. Claims 1-5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 6 is deemed to be indefinite in regards to the phrase: "flowing the fluid under turbulent conditions ( $Re > 3,000$ )," which also happens to be new matter inserted in the present C.I.P. Application. The examiner has no idea what the "Re" in "( $Re > 3,000$ )" stands for since such is never defined in applicant's specification. Furthermore, the phrase: "flowing the fluid under *turbulent conditions* ( $Re > 3,000$ )," is indefinite because the examiner fails to see how a flow of fluid under the conditions of "( $Re > 3,000$ )," can be considered to be "under turbulent conditions" when applicant's

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specification teaches that the flow of a fluid under "(Re <3,000)," conditions is asserted to be "laminar, *stagnant flow*", see section [0062] of the specification. How can a flow of a fluid at (Re 2,999.9) be considered stagnant condition while a flow of fluid under (Re 3,000.1) be considered turbulent condition?

9. Please note. For the following prior-art rejections little weight can be given to applicant's phrase: "flowing the fluid under *turbulent conditions* (Re >3,000)," since the phrase is so indefinite. In any case, the mixing steps of adding the organic ammonium viscoelastic surfactants to water would seem in itself to read on applicant's phrase: "flowing the fluid under *turbulent conditions* (Re >3,000),".

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 6-7 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose U.S. Patent Number 4,534,875 or Rose et al. U.S. Patent Number 4,880,565.

Rose teaches method for heat exchange fluids comprising viscoelastic surfactant compositions. A specifically taught viscoelastic surfactant is cetlytrimethylammonium salicylate. Applicant's claims are deemed to be anticipated over example 1.

Rose et al teaches fluorine containing viscoelastic surfactants. Applicant's claims are deemed to be anticipated over Example 1 when Sample No 1 and 2 are propelled through the metal mesh screen. The viscoelastic surfactant of Sample 1 and 2 is cetlytrimethylammonium salicylate.

It must be noted that neither Rose nor Rose et al directly disclosed that aqueous solutions of viscoelastic surfactants, such as cetyltrimethylammonium salicylate are corrosion inhibitors for metal surfaces. Nevertheless it is held that when the viscoelastic surfactants in aqueous compositions are put in contact with the metal surfaces of the apparatuses above the viscoelastic surfactants in aqueous compositions would inherently reduce/inhibit corrosion of the metal surface. It must be pointed out that all said patents disclose processes of drag reducing that are identical to applicant's claimed process of corrosion inhibiting. Even the disclosed concentration ranges of viscoelastic surfactants in the aqueous compositions are within applicant's claimed range. It is thus held that applicants' have not discovered a new process of use of viscoelastic surfactants in aqueous compositions, but rather has recognized that within well-known processes of using viscoelastic surfactants in aqueous compositions a side benefit of reducing corrosion on metal surfaces occurs in which they come in contact with.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rose U.S. Patent Number 4,534,875 or Rose et al. U.S. Patent Number 4,880,565.

Rose and Rose et al have been described above. They differ from applicant's claimed invention in that there is no direct teaching to the use of an aqueous fluid containing a viscoelastic surfactant such as, cetlytrimethylammonium salicylate within applicant's claimed concentration range of about 1 to about 1,000 ppm.

It would have been obvious to one having ordinary skill in the art to use the individual broad disclosure of each patent as motivation to actually use a concentration of viscoelastic surfactant such as, cetlytrimethylammonium salicylate, at a concentration within applicants' claimed range of about 1 to about 1,000 ppm, see Claims 10 and 15 of Rose '875.

14. Claims 6-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teot et al. U.S. Patent Number 4,615,825 or Rose et al. U.S. Patent Number 4,806,256 or Ohlendorf et al. U.S. Patent Number 4,705,860 or Bonekamp et al. U.S. Patent Number 5,258,137.

All said patents teach the use of viscoelastic surfactants in aqueous compositions as friction or drag reduction agents. The taught viscoelastic surfactants are: cetlytrimethylammonium salicylate, and tetradecylammonium salicylate, see

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examples 2-3 of Teot et al.; cetyltrimethylammonium salicylate alone or used in admixture with dodecyltrimethylammonium salicylate, see example 3 of Rose et al.; n-alkyltrimethyl ammonium n-alkyl-sulfonate and hexadecyl (i.e. cetyl) trimethylammonium salicylate in examples 9 and 12-13 of Ohlendorf et al.; hexadecylammonium salicylate, tetradecylammonium salicylate, cetylpyridinium salicylate, cetyltrimethylammonium salicylate, and erucyltrimethylammonium salicylate, see examples 1-3 of Bonekamp et al..

The said patent differ from applicant's claimed invention in the following ways: 1) there is no direct statement that the viscoelastic surfactants in aqueous compositions also function as corrosion inhibitors for metals, and 2) there is no direct teaching (i.e. by way of an example) to actually contacting a metal surface by the disclosed viscoelastic surfactants in aqueous compositions.

It would have been obvious to one having ordinary skill in the art to use the disclosed viscoelastic surfactants in an aqueous composition in a process wherein the composition contacts a metal surface. This is obvious because all said patents individually disclose that their taught viscoelastic surfactants in aqueous compositions have many uses. One important use being in drilling fluids and other oil recover operations. It is notoriously well known in the oil drilling/recovering art that metal piping is used. It is thus held by the examiner that when the viscoelastic surfactants in aqueous compositions are pumped through these metal pipes to reduce the drag/friction of the fluids passing there through, the viscoelastic surfactants in aqueous compositions would inherently reduce/inhibit corrosion of the metal surface of the pipes. It must be



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pointed out that all said patents disclose processes of drag reducing that are identical to applicant's claimed process of corrosion inhibiting. Even the disclosed concentration ranges of viscoelastic surfactants in the aqueous compositions are within applicant's claimed range. It is thus held that applicant has not discovered a new process of use of viscoelastic surfactants in aqueous compositions, but rather has recognized that within well known processes of using viscoelastic surfactants in aqueous compositions a side benefit of reducing corrosion on metal surfaces occurs in which they come in contact with.

15. Claims 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas et al. U.S. Patent Number 4,584,109.

Haas et al. teach the use of viscoelastic surfactants in aqueous compositions as friction or drag reduction agents particular in tertiary production of crude oil. The taught viscoelastic surfactants can be selected from organic ammonium salts of the formula  $R_1-N^+(R_2)(R_2'')(R_2')A^-$ , wherein  $(R_2)$  and  $(R_2')$  are lower alkyl groups and  $(R_2'')$  can be a lower alkyl group or an ethoxylated group having from 1 to 3 ethoxy groups and  $A^-$  is an anion such as a salicylate group or sulfonate group, see abstract, column 2, lines 12-14, column 3, lines 35-42, and claims 2 and 7.

Haas et al. differ from applicant's claimed invention in the following ways: 1) there is no direct statement that the viscoelastic surfactants in aqueous compositions also function as corrosion inhibitors for metals, and 2) there is no direct teaching (i.e. by way

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of an example) to actually contacting a metal surface by the disclosed viscoelastic surfactants in aqueous compositions.

It would have been obvious to one having ordinary skill in the art to use the disclosed viscoelastic surfactants in an aqueous composition in a process wherein the composition contacts a metal surface. This is obvious because Haas et al. disclose that their taught viscoelastic surfactants in aqueous compositions have many uses. One important use being in drilling fluids and other oil recover operations. It is notoriously well known in the oil drilling/recovering art that metal piping is used. It is thus held by the examiner that when the viscoelastic surfactants in aqueous compositions are pumped through these metal pipes to reduce the drag/friction of the fluids passing there through, the viscoelastic surfactants in aqueous compositions would inherently reduce/inhibit corrosion of the metal surface of the pipes. It must be pointed out that Haas et al's disclose processes of drag reducing that are identical to applicant's claimed process of corrosion inhibiting. Even the disclosed concentration ranges of viscoelastic surfactants in the aqueous compositions are within applicant's claimed range. It is thus held that applicant has not discovered a new process of use of viscoelastic surfactants in aqueous compositions, but rather has recognized that within well known processes of using viscoelastic surfactants in aqueous compositions a side benefit of reducing corrosion on metal surfaces occurs in which they come in contact with.

***Response to Arguments***

16. The flowing remarks were made in the Final Rejection of the Parent Application and are repeated here because they are still deemed to be highly relevant to the present claims.

"Applicant's arguments filed 07/16/03 with the amendment have been fully considered but are not persuasive to put the application in condition for allowance for the reasons given above. Additional examiner comments are made below.

Applicant tries to rebut the examiner's assertion that the compositions as taught and used by the applied prior art, would inherently function as corrosion inhibitors as well as viscoelastic compositions. Applicant's rebuttal uses certain court citations on page 9 of the amendment wherein the courts: "If the prior-art reference does not expressly set forth a particular element of the claims, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. . ." The examiner contends that such court citations are not relevant to the factual situation in the present application because the applied prior-art references DO NOT LACK any ELEMENT that is contained in applicant's method of use claims. The compositions taught by the applied prior-art, and the method steps used by the applied prior-art are identical with applicant's claimed method steps. There is thus NO missing element in the applied prior-art references.

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What the examiner has asserted is that applicant's requirement that the compositions used in applicant's claimed methods provide a corrosion inhibiting function, is inherently met when the applied prior-art compositions are used, even though such a corrosion inhibiting property was not recognized by said prior-art. Furthermore, applicant have presented absolutely no proof that the prior-art compositions and their methods wherein metal surfaces are contacted with the compositions, will not inherently perform a corrosion inhibiting functions along with a viscoelastic function. It is well known in patent law that the discovery of a new property in an otherwise old composition does not by itself impart patentability to the old compositions. Likewise, the discovery of a new property that occurs when an old composition is used in an old method does not impart patentability to the old method."

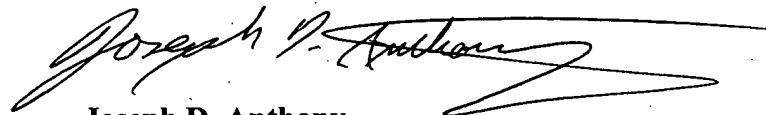
***Prior-Art Cited But Not Applied***

17. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention. Please note that all the prior-art references cited on the form PTO-892 teach that it is known in the art that many organic ammonium surfactant species are well known to function corrosion inhibitors. The same is taught by applicant's cited prior-art reference to GB 2,299,331 A. These said references were not applied over applicant's claims since the taught species of organic ammonium surfactants do not fall within the scope of applicant's claimed formula (1) of independent claims 6 and 12.

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***Examiner Information***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



**Joseph D. Anthony**  
**Primary Patent Examiner**  
**Art Unit 1714**

*2/11/06*